

REMARKS

The Examiner rejected claims 1-21 under 35 U.S.C. §103(a) as allegedly being unpatentable over Sherr et al. (US 20020154157) in view of Official Notice.

Applicants respectfully traverse the §103(a) rejections with the following arguments.

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35 U.S.C. §103(a)

The Examiner rejected claims 1-21 under 35 U.S.C. §103(a) as allegedly being unpatentable over Sherr et al. (US 20020154157) in view of Official Notice.

Claims 1-3

Applicants respectfully contend that claim 1 is not unpatentable over Sherr in view of Official Notice, because Sherr in view of Official Notice does not teach or suggest each and every feature of claim 1. For example, Sherr in view of Official Notice does not teach or suggest the feature: "showing a shopping summary in response to detecting the right click".

The Examiner argues: "Sherr teaches displaying an order page initiated by a right mouse click (page 7, para 071), but does not specifically mention showing a shopping summary in response to detecting the right click. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Sherr, a shopping summary as claimed in the instant invention, because this would permit buyers of the system to use the right click option for any presentation of information that was considered important enough to command the use of the right click option. Offering this flexibility would increase the sale and use of the system and thus create increased revenue for the company by satisfying the needs of the customer."

In response, Applicants respectfully contend that the Examiner's statement of: "It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Sherr, a shopping summary as claimed in the instant invention, because this would permit buyers of the system to use the right click option for any presentation of information that was considered important enough to command the use of the right click option" is vague and

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indefinite, and reflects unsupported speculation by the Examiner.

Applicants have challenged the Examiner, under MPEP 2144.03C, to provide adequate evidence to support the preceding statement of the Examiner. The Examiner has responded in "Response to Arguments" by stating: "Applicant requests that the examiner provide an evidentiary article to support his contention of official notice. In response, the examiner presents the helpcommunity article that teaches programmers how to program the right click button to add any functionality." In response, Applicants note that the "helpcommunity article" merely provides instructions on how to add a right-click functionality to software and does not include any support for the Examiner's argument as to why it is allegedly obvious to perform the step of "showing a shopping summary in response to detecting the right click". In fact, Applicants respectfully contend that the "helpcommunity article" has no relevance as to whether claim 1 is unpatentable over Sherr in view of Official Notice. Applicants also note that the Examiner has not included the "helpcommunity article" in the grounds for rejection of claim 1. Therefore, the "helpcommunity article" has no argumentative weight in the grounds for the rejection of claim 1.

Applicants respectfully again challenge the Examiner, under MPEP 2144.03C, to provide adequate evidence to support the preceding statement of the Examiner of: "It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Sherr, displaying bidding summaries as claimed in the instant application, because this would permit buyers of the system to use the right click option for any presentation of information that was considered important enough to command the use of the right click option".

Applicants respectfully contend that the Examiner's statement of: "offering this flexibility would increase the sale and use of the system and thus create increased revenue for the company

by satisfying the needs of the customer" is incorrect and reflects unsupported speculation by the Examiner. Applicants again respectfully challenge the Examiner, under MPEP 2144.03C, to provide adequate evidence to support the preceding statement of the Examiner.

Applicants respectfully contend that the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Sherr by the Examiner's unsupported allegation of Official Notice in relation to claim 1. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001 ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention"). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984 ("The mere fact that the prior art could be so modified would not have made the motivation obvious **unless the prior art suggested the desirability of the modification.**")). The Examiner has not made any showing of where the prior art suggests "showing a shopping summary in response to detecting the right click". Additionally, the Examiner has not made any showing of where the prior art teaches that "offering this flexibility would increase the sale and use of the system and thus create increased revenue for the company by satisfying the needs of the customer". Thus, the Examiner has provided a reason for the modification of Sherr by the Examiner's speculation using hindsight reconstruction in conjunction with the Examiner's personal opinion, and not by teachings of the prior art. By not citing any suggestion or incentive

in the prior art for "showing a shopping summary in response to detecting the right click", and by not citing any teaching in the prior art of: "offering this flexibility would increase the sale and use of the system and thus create increased revenue for the company by satisfying the needs of the customer", the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 1.

Based on the preceding arguments, Applicants respectfully maintain that claim 1 is not unpatentable over Sherr in view of Official Notice, and that claim 1 is in condition for allowance. Since claims 2-3 depend from claim 1, Applicants contend that claims 2-3 are likewise in condition for allowance.

Claims 4-6

Applicants respectfully contend that claim 4 is not unpatentable over Sherr in view of Official Notice, because Sherr in view of Official Notice does not teach or suggest each and every feature of claim 4. For example, Sherr in view of Official Notice does not teach or suggest the feature: "showing a shopping cart responsive to detecting the right click of the computer mouse on the on-line shopping web page".

The Examiner argues: "see response to claim 1, and FIG 14". In response, Applicants cite Applicants' arguments relating to claim 1.

In addition, Applicants respectfully contend that FIG. 14 of Sherr depicts an "open order ticket page" (see Sherr, paragraph 0105, lines 1-3) which is not a "shopping cart". A "shopping cart" comprises a list of goods to be purchased (see Applicants' specification, page 1, lines 14-17). In contrast, an "open order ticket page" comprises a list of goods previously purchased

(see Sherr, paragraph 0105, lines 1-8). Therefore, the Examiner's citation of FIG. 14 of Sherr is not persuasive and the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 4.

Based on the preceding arguments, Applicants respectfully maintain that claim 4 is not unpatentable over Sherr in view of Official Notice, and that claim 4 is in condition for allowance. Since claims 5-6 depend from claim 4, Applicants contend that claims 5-6 are likewise in condition for allowance.

Claims 7-9

Applicants respectfully contend that claim 7 is not unpatentable over Sherr in view of Official Notice, because Sherr in view of Official Notice does not teach or suggest each and every feature of claim 7. For example, Sherr in view of Official Notice does not teach or suggest the feature: "showing a bidding summary responsive to detecting the right click of the computer mouse on the on-line auction web page".

The Examiner argues: "Sherr teaches displaying an order page initiated by a right mouse click (page 7, para 071), but does not specifically mention showing a bidding summary in response to detecting the right click. It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Sherr, displaying bidding summaries as claimed in the instant application, because this would permit buyers of the system to use the right click option for any presentation of information that was considered important enough to command the use of the right click option. Offering this flexibility would increase the sale and

use of the system and thus create increased revenue due to satisfying the needs of the customer.”

In response, Applicants respectfully contend that the Examiner’s statement of: “It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Sherr, displaying bidding summaries as claimed in the instant application, because this would permit buyers of the system to use the right click option for any presentation of information that was considered important enough to command the use of the right click option” is vague and indefinite, and reflects unsupported speculation by the Examiner.

Applicants have challenged the Examiner, under MPEP 2144.03C, to provide adequate evidence to support the preceding statement of the Examiner. The Examiner has responded in “Response to Arguments” by stating: “Applicant requests that the examiner provide an evidentiary article to support his contention of official notice. In response, the examiner presents the helpcommunity article that teaches programmers how to program the right click button to add any functionality.” In response, Applicants note that the “helpcommunity article” merely provides instructions on how to add a right-click functionality to software and does not include any support for the Examiner’s argument as to why it is allegedly obvious to perform the step of “showing a bidding summary responsive to detecting the right click of the computer mouse on the on-line auction web page”. In fact, Applicants respectfully contend that the “helpcommunity article” has no relevance as to whether claim 7 is unpatentable over Sherr in view of Official Notice. Applicants also note that the Examiner has not included the “helpcommunity article” in the grounds for rejecting claim 7. Therefore, the “helpcommunity article” has no argumentative weight in the grounds for the rejection of claim 7.

Applicants respectfully again challenge the Examiner, under MPEP 2144.03C, to provide

adequate evidence to support the preceding statement of the Examiner of: "It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Sherr, displaying bidding summaries as claimed in the instant application, because this would permit buyers of the system to use the right click option for any presentation of information that was considered important enough to command the use of the right click option".

In addition, Applicants respectfully contend that the Examiner's statement of: "offering this flexibility would increase the sale and use of the system and thus create increased revenue due to satisfying the needs of the customer" is incorrect and reflects unsupported speculation by the Examiner. Applicants respectfully again challenge the Examiner, under MPEP 2144.03C, to provide adequate evidence to support the preceding statement of the Examiner.

Applicants respectfully contend that the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Sherr by the Examiner's unsupported allegation of Official Notice in relation to claim 7. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001 ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention"). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984 ("The mere fact that the prior art could be so modified would not have made the motivation obvious unless the prior art suggested the desirability of the modification.")).

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The Examiner has not made any showing of where the prior art suggests "showing a bidding summary responsive to detecting the right click of the computer mouse on the on-line auction web page". Additionally, the Examiner has not made any showing of where the prior art teaches that "offering this flexibility would increase the sale and use of the system and thus create increased revenue for the company by satisfying the needs of the customer". Thus, the Examiner has provided a reason for the modification of Sherr by the Examiner's speculation using hindsight reconstruction in conjunction with the Examiner's personal opinion, and not by teachings of the prior art. By not citing any suggestion or incentive in the prior art for "showing a bidding summary responsive to detecting the right click of the computer mouse on the on-line auction web page", and by not citing any teaching in the prior art of: "offering this flexibility would increase the sale and use of the system and thus create increased revenue for the company by satisfying the needs of the customer", the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 7.

Based on the preceding arguments, Applicants respectfully maintain that claim 7 is not unpatentable over Sherr in view of Official Notice, and that claim 7 is in condition for allowance. Since claims 8-9 depend from claim 7, Applicants contend that claims 8-9 are likewise in condition for allowance.

Claims 10-14

Applicants respectfully contend that claim 10 is not unpatentable over Sherr in view of Official Notice, because Sherr in view of Official Notice does not teach or suggest each and every feature of claim 10. For example, Sherr in view of Official Notice does not teach or

suggest the feature: "deriving a screen location from screen coordinates of the computer mouse; creating an overlay that includes a shopping summary; and showing the overlay upon the web page at the derived location."

The Examiner argues: "Sherr discloses a method of presenting a shopping summary for electronic commerce, comprising the acts of: detecting a right click of a computer mouse on a web page (page 7, para 071); deriving a screen location from screen coordinates of the computer mouse (page 6, para 0067); creating an overlay that includes a shopping summary (FIG 2, item 206); and showing the overlay upon the web page at the derived location (FIG 2, item 206)."

In response, Applicants respectfully contend that Sherr does not teach or suggest "deriving a screen location from screen coordinates of the computer mouse" in Sherr, paragraph 0067. There is absolutely no disclosure of "screen coordinates of the computer mouse" in Sherr, paragraph 0067.

In additional response, Applicants respectfully contend that streaming box 206 in FIG. 2 of Sherr does not include a shopping summary, as required by claim 10.

In further response, Sherr does not disclose that streaming box 206 in FIG. 2 of Sherr is positioned at the screen location that was derived from the screen coordinates of the computer mouse, as required by claim 10.

Based on the preceding arguments, Applicants respectfully maintain that claim 10 is not unpatentable over Sherr in view of Official Notice, and that claim 10 is in condition for allowance. Since claims 11-14 depend from claim 10, Applicants contend that claims 11-14 are likewise in condition for allowance.

Claims 15-21

Applicants respectfully contend that claim 15 is not unpatentable over Sherr in view of Official Notice, because Sherr in view of Official Notice does not teach or suggest each and every feature of claim 15. For example, Sherr in view of Official Notice does not teach or suggest the feature: "when the right click is detected, determining whether a shopping summary is shown." The Examiner does not even allege that Sherr discloses said "determining" feature of claim 15.

As another example, Sherr in view of Official Notice does not teach or suggest the feature: "if the shopping summary is shown upon detection of the right click, retiring the shopping summary; and if the shopping summary is not shown upon detection of the right click, showing the shopping summary."

The Examiner argues: "In response to claim 15, Sherr discloses using the right click of a mouse to perform a limited programmed function such as entering an order page within a current webpage (see response to claims 1-14), but does not specifically mention that the right click is used to open and close an application such as a shopping summary. Turning programs on and off utilizing a single on/off switch activation mechanism such as a mouse click is old and well known in the art. It would have been obvious to a person having ordinary skill in the art to change the right click programming to include on/off capability, because this would improve the system of Sherr by turning off a program that was activated with the right click and removing information that was not currently needed thus creating a less cluttered webpage."

In response, Applicants assert that Sherr does not disclose a "shopping summary" and Applicants cite Applicants' arguments relating to claims 1 and 4.

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In further response, Applicants note that the Examiner has cited USP 6,018,571 to Langlois et al. in "Response to Arguments" but has not included USP 6,018,571 in the grounds for rejecting claim 15. In other words, the Examiner has not rejected claim 15 under 35 U.S.C. §103(a) as allegedly being unpatentable over Sherr et al. (USP 20020154157) in view of Langlois et al. (USP 6,018,571). Therefore, Sherr et al. (USP 20020154157) has no argumentative weight in the grounds for the rejection of claim 15.

Applicants again respectfully challenge the Examiner, under MPEP 2144.03C, to provide adequate evidence to support use of a right mouse click to turn off a shopping summary.

Applicants respectfully contend that the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Sherr by the Examiner's unsupported allegation of Official Notice in relation to claim 15. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention"). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the motivation obvious unless the prior art suggested the desirability of the modification."). The Examiner has not made any showing of where the prior art suggests "when the right click is detected, determining whether a shopping summary is shown". Additionally, the Examiner has

not made any showing of where the prior art teaches that "this would improve the system of Sherr by turning off a program that was activated with the right click and removing information that was not currently needed thus creating a less cluttered webpage". Thus, the Examiner has provided a reason for the modification of Sherr by the Examiner's speculation using hindsight reconstruction in conjunction with the Examiner's personal opinion, and not by teachings of the prior art. By not citing any suggestion or incentive in the prior art for "when the right click is detected, determining whether a shopping summary is shown", and by not citing any teaching in the prior art of: "this would improve the system of Sherr by turning off a program that was activated with the right click and removing information that was not currently needed thus creating a less cluttered webpage", the Examiner has failed to establish a *prima facie* case of obviousness in relation to claim 15.

Based on the preceding arguments, Applicants respectfully maintain that claim 15 is not unpatentable over Sherr in view of Official Notice, and that claim 15 is in condition for allowance. Since claims 16-21 depend from claim 15, Applicants contend that claims 16-21 are likewise in condition for allowance.

CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account 09-0457.

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